



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,151	10/12/2000	John J. Sie	19281-000600US	8606

20350 7590 07/14/2005

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

BROWN, RUEBEN M

ART UNIT PAPER NUMBER

2611

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/687,151	SIE ET AL.	
	Examiner	Art Unit	
	Reuben M. Brown	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 14-20 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/27/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 14-20 & 23 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The amendment to claim 14, recites “wherein the transmitting steps are performed with different media chosen from the group consisting of a multicast media or singlecast media”. Thus amended claim 14 is now directed to the type of media or media transmission scheme, properly classified in 725/97, which is Scheduling, (e.g., grouping users together). Multicast or singlecast transmission techniques are concerned with the grouping of subscribers for the transmission of media.

However, amended claim 1 recites a “method for receiving”... “wherein the first portion is at least one eighth of the program”, whereas claim 9 recites a “method of transmitting”... “wherein the first segment is at least fifteen minutes”... “storing the first set of segments”. Thus claims 1 & 9 are directed to the length or duration of the first portion of a movie stored in a user terminal, and is properly classified in 725/89, which is Video on Demand, by use of memory at receiver.

Art Unit: 2611

The restriction is proper since it has been demonstrated that claim 14, includes divergent subject matter, as noted by the difference in classification and search areas.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14-20 & 23 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

2. Applicant's arguments with respect to claims 1 & 9 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that since Garfinkle teaches that the lead-in segment may be of the order of two minutes, the reference does not read on the amended claimed feature of "the first portion of at least one-eighth of the program" (claim 1) or "the first segment is at least fifteen minutes" (claim 9). However, examiner points out that it has long been established that changes in size/proportion/range would have been an obvious modification for one of ordinary skill in the art; *In re Rose*, 220 F.2d 459 105 USPQ 237 (CCPA 1955) and *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976), "mere scaling up of prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled".

Art Unit: 2611

Examiner points out that Garfinkle does not contain any language that limits the size of the lead-in, the reference merely discloses an acceptable length of lead-in segments. Clearly, at the time the invention was made, it was known that at least two of the limiting factors for storing information on a receiver were the amount of available memory, and the price of memory devices/units. Thus, as techniques for memory storage using more sophisticated compression, and less expensive manufacturing costs, it would have become more feasible to store greater length of the lead-in segments, at a receiver.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-13 & 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle, (U.S. Pat # 5,530,754).

Considering amended claim 1, the claimed method for receiving a program by a user location that is sent from a content distributor, comprising receiving and storing a first portion of the program at the user location, reads on the disclosure in Garfinkle of receiving and storing a

Art Unit: 2611

lead-in segment of a movie in the catalog store memory 22 at a user site 18; see Fig. 1; col. 1, lines 54-67 thru col. 2, lines 1-12; col. 3, lines 5-32; col. 4, lines 19-21 & col. 4, lines 48-50.

The claimed method of detecting a user request for the program after storage of the first portion and receiving a second portion of the program in response to the user request is also met by the teachings of Garfinkle; col. 3, lines 25-31; col. 3, lines 60-67; col. 4, lines 1-16 & col. 5, lines 10-15.

In particular, Garfinkle teaches that after a viewer watches previews of various movies, the instant viewer may choose product, i.e., movie, which is generally stored at a central site. This full-length product is then transmitted to the viewer, col. 3, lines 10-14; col. 3, lines 65-67 thru col. 4, lines 1-12 & col. 5, lines 3-9.

As for the amended claimed feature of: 'wherein the first portion is at least one eighth of the program', Garfinkle merely discusses that the lead-in segment may be on the order of two minutes, col. 4, lines 21-35. Official Notice is taken that at the time the invention was made, access to larger memory units/cache was well known in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Garfinkle with the well-known technology of expanded memory capacity, which enables longer durations of the lead-in segments to be stored on the receiver, for example such as an hour or more, at least for the desirable improvement of expanding the time available for the system to download the rest of the movie.

For instance, if only two minutes are stored, then once the lead-in begins playing, the system has less than two minute to find, retrieve, download and seamlessly splice the next segment of the movie, which could cause delay, (such as the customer not receiving the next segment), if there is are serious problems on the network. Whereas if more of the movie is cached, such as 60 minutes, the system has significantly more time to resolve networks failures, that may be delaying the transmission of a requested remainder of a movie.

Considering claims 2 & 11, if the viewer's home equipment has downloaded and stored a lead-in segment of the movie that the viewer has just selected, then the lead-in segment is retrieved from the catalog store 22, and begins to be displayed for the viewer; see Abstract; col. 1, lines 64-67 & col. 4, lines 12-25.

Considering claims 3 & 12, the instant claims recite that a first time associated with playing the first portion is equal to or greater than a second time associated with receiving or transmitting a second or plurality of portions. Accordingly, Garfinkle discloses that "the lead-in" which is stored at a user location memory 22 and played when a user selects its corresponding video product (i.e., movie), "is an initial segment of the video product sufficient in length to allow the downloading of the selected product to the user site", see col. 4, lines 19-35. Garfinkle goes on to further explain that, "For example, the lead-in segment may be of the order of two minutes long. In order to provide a seamless transition or splice from the catalog stored lead-in to the full video program stored material downloaded...".

It is noted that the claims do not recite any restrictions regarding the length of the second portion itself, specifically as compared to the first portion. Therefore Garfinkle's disclosure that the lead-in segment is of sufficient length to allow the downloading of the selected product reads on the claimed subject matter. For instance, Garfinkle discusses that if the user terminal does not have enough memory to store the entire movie, that the instant movie is transmitted in segments; col. 5, lines 14-22. The first transmission is only as much as the user terminal can store. When a certain number of minutes of the movie remain that have not been played from a particular segment, then the system transmits the next segment. Therefore the time needed to playback a downloaded portion of the movie is longer than the time for downloading the next portion of the movie.

Considering claim 4, Garfinkle discusses the use of a user input device 28, without explicitly disclosing that user input device uses wireless technology; see col. 3, lines 50-54 & Fig. 3. Official Notice is taken that at the time the invention was made, wireless TV remote control was old in the art, using either RF or infrared technology. It would have been obvious for one of ordinary skill in the art at the time the invention was made to operate Garfinkle with a wireless remote control, for the desirable benefit of improving upon the use of hard wired input devices, generally providing the user with a wider range of distance for inputting commands and obviates the cumbersome nature of wires. As for the claimed processing the request to determine a desired program; the instant subject matter is met by col. 3, lines 62-67.

Art Unit: 2611

Considering claims 5 & 13, the programs in Garfinkle that include a lead-in segment read on the recited programs consisting of a first and second portion; col. 4, lines 12-67.

Considering claim 6, even though the user site 18 of Garfinkle includes numerous functions of a set-top box, the reference does not explicitly disclose a set-top box. Official Notice is taken that at the time the invention was made, it was well known in the art to use a set-top box in a video-on-demand system. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Garfinkle with the feature of a set-top box, at least for the well known benefits of a set-top box, such as increased flexibility and processing power.

Considering claim 7, Garfinkle generally discusses a storage medium used to house the catalog store memory 22; col. 3, lines 5-30, but does not explicitly state the use of a mass storage device. Official Notice is taken that at the time the invention was made, that using a mass storage device, such as a laserdisc or DVD in conjunction with a set-top box for VOD was well-known in the art. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Garfinkle with the feature of mass storage device, such as laserdisc or DVD, at least for the desirable advantages of high amount of memory available on physically small device, which are smaller than VHS tapes, for instance.

Considering claim 8, the claimed feature of determining a subset of programs from a linear schedule of programs and dividing each of the subset of programs into a respective first

Art Unit: 2611

and second respective portion reads on the server in Garfinkle periodically transmitting the lead-in segments for any group of movies, col. 2, lines 1-12; col. 4, lines 45-58. It is disclosed that lead-ins are only generated for 'certain products', which reads on 'determining a subset of programs'. The additionally claimed feature of transmitting a plurality of the respective first portions to the user location is also met by the above-cited disclosure of Garfinkle and col. 3, lines 5-17.

Considering claim 9 Garfinkle teaches that a certain of the movies at a central station 10, have lead-in segments, which reads on the claimed 'determining a linear schedule of content programs, wherein each content comprises a first segment and a second segment'; see col. 2, lines 1-8.

The additional step of storing a second set of segments remotely from a user location reads on col. 4, lines 35-46, which discusses movies being housed in a product store 12 of the central station 10. The additionally claimed features of transmitting and storing a first set of segments to the user location, and transmitting one of the second set of segments to the user location, after a request from the user is met by col. 3, lines 1-30; col. 4, lines 12-35 & Fig. 5.

As for the amended claimed feature: 'wherein the first segment is at least fifteen minutes', represents a logical extension of the subject matter found in claim 1, and is likewise analyzed.

Art Unit: 2611

Considering claim 10, the claimed feature of transmitting a commercial to the user location reads on the disclosure of Garfinkle of downloading trailers or previews to the subscriber; col. 2, lines 1-6; col. 4, lines 9-12.

Considering claims 21 & 22, the claimed features correspond with subject matter mentioned above in the rejection of claims 1 & 9, and are likewise treated.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2611

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:


(571) 273-7290 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F (9:00-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown


CHRIS GRANT
PRIMARY EXAMINER